

REMARKS

Claims 1-10 are pending in the application. Claim 10 has been canceled and claim 8 has been amended.

Objection to the Specification

The Examiner objects to the abstract of the disclosure as lacking a chemical formula. The above amendment inserts formula I into the abstract thereby obviating this objection.

Objection to the Claims

The Examiner objects to claim 1 for having a typographical error. Claim 1 has been amended to correctly read "and (4)" at line 17.

The Examiner objects to claims 1-9 for containing numbers to the left of the claims. The numbers appear to be line numbers routinely included in PCT applications, and they are not part of the claims.

Rejection under 35 U.S.C. 112 (2nd paragraph)

Claim 8 stands rejected under 35 U.S.C. 112, second paragraph as being indefinite. Claim 8 has been amended to delete entries in which R⁴ is unsubstituted isoxazolyl and R³ is other than fluorine. The amendment overcomes the rejection and its withdrawal is respectfully requested.

Double Patenting

Claims 1-9 stand rejected under the doctrine of obviousness-type double patenting over claims 1-9, 12-15, 17, and 20-26 of US Patent No. 7,163,951. A terminal disclaimer is submitted herewith thereby obviating this ground of rejection, and its withdrawal is respectfully requested.

Rejection under 35 U.S.C. 103

Claims 1-3, 5, 6, 8 and 9 stand rejected under 35 U.S.C. 103(a) as allegedly obvious over Kuduk et al (WO2004/019868), which is available as prior art only under 35 U.S.C. 102(e). The instant application and Kuduk et al were, at the time the invention in the instant application was made, subject to an obligation of assignment to Merck & Co., Inc. Accordingly, Kuduk et al is disqualified under 35 U.S.C. 103(c) as prior art. Withdrawal of this ground of rejection is respectfully requested.

Rejection under 35 U.S.C. 112 (1st paragraph)

Claims 1, 2 and 9 stand rejected under 35 U.S.C. 112, first paragraph as allegedly not fully supported by an enabling disclosure of the specification. Applicants respectfully traverse.

The Examiner states that "the specification, while being enabling for compounds and/or compositions where if R⁴ is C₁₋₆alkyl, the groups in which said alkyl may be substituted with include halogen, nitro cyano, and SO₂R^d, does not reasonably provide enablement for the other thousands of compounds that applicant is claiming." As this ground of rejection is not applied to claims 3-8, the R⁴ groups in these claims are therefore deemed fully enabled by the disclosure.

It is well established that a specification must be taken as in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. It is incumbent upon the Patent Office to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up such assertions with acceptable evidence or reasoning which is inconsistent with the contested statement. In the instant case, the Examiner did not present any evidence or reasoning why the various R⁴ groups are not enabled by the specification; there is no evidence or reasoning why a skilled person would not be able to make or use the claimed compounds/compositions. The discussion of the Wands factors does not suffice to support a case of *prima facie* nonenablement. Applicants respectfully request the withdrawal of this rejection.

Serial No.: 10/590542
Case No.: 21654P
Page No.: 14

In light of the above amendment and remarks, applicants submit that the application is in condition for allowance. An early favorable action is respectfully requested. The Commissioner is hereby authorized to charge any fees connected with this correspondence to Deposit Account No. 13-2755.

Respectfully submitted,

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